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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,978	09/05/2003	David U. Hillstrom	MDI 0595 PUS	9727

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EXAMINER

SILBERMANN, JOANNE

ART UNIT

PAPER NUMBER

3611

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/656,978	<b>Applicant(s)</b> HILLSTROM, DAVID U.	
	<b>Examiner</b> Joanne Silberman	<b>Art Unit</b> 3611	

-- Th MAILING DATE of this communication appears on the cover sheet with the correspond nc address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 12-71 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) \_\_\_\_ is/are rejected. 1, 12-47, 49-51, 53-54, 56-71
- 7) ☒ Claim(s) \_\_\_\_ is/are objected to. 48, 52, 55
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                                    |

## **DETAILED ACTION**

### ***Double Patenting***

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claim 1 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 5,983,543. This is a double patenting rejection.

### ***Claim Objections***

3. Claims 1, 51 and 53 are objected to because of the following informalities: In claim 1 line 2 "illustrated" should be "illuminated". In claim 51 "nap-fit" should be "snap-fit". Claim 53 should end in a period. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 56 and 62-64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 56 "said mating male and female connectors" lacks antecedent basis.

Claims 62-64 depend from 56, but 56 is not a method.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 12, 13, 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Russell, US #1,258,146.

8. Russell discloses a display module including a generally rectangular frame (Figure 1) having first and second opposed, spaced apart, elongate vertically disposed frame members and third and fourth opposed spaced-apart, elongate horizontally disposed frame members connected together adjacent their ends, wherein a plane passes through all these members, a plurality of horizontally disposed elongate divider members 30 individually removably held in place on the first and second frame members substantially in the place in vertically spaced apart relation by mating male and female connectors 33 and 23 (Figure 2), channels in each of the dividers (Figure 1) for securing display members 35, wherein the divider members may be removed without disassembly of the frame and the display members may be provided in various vertical dimensions.

9. The third and fourth frame members also include dividers, and thus, channels, as shown in Figure 1.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russell.

12. Russell teaches the male connection members on the divider and the female on the frame members, however, reversing these parts would have been obvious to a person having ordinary skill in the art since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167.

13. Claims 17-47, 49-51, 53, 54 and 56-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russell in view of Harkins et al. US #4,364,616.

14. Russell teaches retention member 25 secured on the frame members.

15. Russell also teaches using transparent indicia and a source of illumination (page 1 lines 80-84) but does not specifically describe the housing, etc. Such housing for an illuminated sign is well known in the art, as shown by Harkins et al. Harkins et al. teaches a housing, illumination, a glass door and a translucent display. It would have been obvious to one of ordinary skill in the art to utilize such structure in combination with Russell so as to provide the housing, etc. suggested by Russell.

16. It would have been obvious to reverse the male and female parts, as discussed above. The male parts constitute a plurality of fingers that snap fit with the female connectors.

17. Russell and Harkins et al. do not specifically teach methods of assembling or operating the display, however, the method steps of the instant claims would have been obvious to one of ordinary skill in the art given the structure of Russell and Harkins et al.

18. Harkins et al. teach a plurality of modules in a display and the display supported on a structure, as in Figure 3.

***Allowable Subject Matter***


19. Claims 48, 52 and 55 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

20. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record does not teach or suggest a display as claimed in claims 47, 49, or 54 and further including the specific detail of the leg and finger elements of the divider and retention means, as described in claims 48, 52 and 55.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joanne Silbermann whose telephone number is 703-308-2091. The examiner can normally be reached on Tu-Th 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 703-308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Joanne Silberman  
Primary Examiner  
Art Unit 3611

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